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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,978	08/31/2001	Ken Kutaragi	100809-16279 (SCEW) 18.968	7677

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KATTEN MUCHIN ROSENMAN LLP
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EXAMINER

VAN HANDEL, MICHAEL P

ART UNIT	PAPER NUMBER
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2623

MAIL DATE	DELIVERY MODE
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05/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	09/942,978	KUTARAGI ET AL.	
	Examiner	Art Unit	
	MICHAEL VAN HANDEL	2623	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 April 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): 9 and 11 under 35 USC 101.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1-9 and 11.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Chris Kelley/
Supervisory Patent Examiner, Art Unit 2623

Continuation of 11.

The examiner hereby withdraws the rejection of claims 9 and 11 under 35 USC 101 in light of the amendment.

Regarding claims 9 and 11, the applicant argues that the specification includes clear description and corresponding functionality of a program. The examiner respectfully disagrees. The applicant specifically argues that programs can include particular structure, especially in view of object-oriented programming wherein "objects" define the structure and corresponding functionality of a program. As noted in the Office Action mailed 12/07/2007, the claims appear to be directed to a program per se, but the limitations appear to be directed toward a particular structure. 35 USC 112, second paragraph requires that claims "particularly point out and distinctly claim the subject matter which the applicant regards as his invention." For means-plus-function elements, which are statutorily limited to the "corresponding structure, material, or acts described in the specification and equivalents thereof," 35 USC 112, sixth paragraph and 35 USC 112, second paragraph require that the specification must permit one of ordinary skill in the art to "know and understand what structure corresponds to the means limitation." For computer-implemented means-plus-function claims where the disclosed structure is a computer programmed to implement an algorithm, "the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm." Thus the patent must disclose, at least to the satisfaction of one of ordinary skill in the art, enough of an algorithm to provide the necessary structure under 35 USC 112, sixth paragraph. Simply reciting "software" without providing some detail about the means to accomplish the function is not enough. "For a patentee to claim a means for performing a particular function and then to disclose only a general purpose computer as the structure designed to perform that function amounts to pure functional claiming. Because general purpose computers can be programmed to perform very different tasks in very different ways, simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to the 'corresponding structure, material, or acts' that perform the function, as required by 35 USC 112, sixth paragraph" (see the recent *Finisar Corp. v. The DirectTV Group* decision on April 18, 2008 - opinion 07-1023 of the US Court of Appeals for the Federal Circuit).

Regarding Applicant's argument that Stefik et al. teaches away from the invention, the examiner notes that "Arguments that the alleged anticipatory prior art is nonanalogous art 'or teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not germane" to a rejection under section 102." *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). See also *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1068, 68 USPQ2d 1481, 1488 (Fed. Cir. 2003) (The question of whether a reference is analogous art is not relevant to whether that reference anticipates. A reference may be directed to an entirely different problem than the one addressed by the inventor, or may be from an entirely different field of endeavor than that of the claimed invention, yet the reference is still anticipatory if it explicitly or inherently discloses every limitation recited in the claims.). A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference "teaches away" from the invention is inapplicable to an anticipation analysis. *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The prior art was held to anticipate the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed."). >See *Upsher-Smith Labs. v. Pamlab, LLC*, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005)(claimed composition that expressly excluded an ingredient held anticipated by reference composition that optionally included that same ingredient);< see also *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999) (Claimed composition was anticipated by prior art reference that inherently met claim limitation of "sufficient aeration" even though reference taught away from air entrapment or purposeful aeration.).

Further regarding claims 1, 6, and 9, the applicant argues that Stefik et al. fails to disclose said digital information itself providing functionality to said user terminal. The examiner respectfully disagrees. The applicant specifically argues that the usage rights of Stefik et al. only include a number of parameters and references that rely upon predefined secure functions performed by the "enforcement elements" to make use of such parameters accordingly. In other words, the applicant argues, the usage rights, in isolation, do not themselves provide any functionality, but they merely call functions already defined in the entities that refer to those usage rights for performing functions according to parameters defined in the usage rights. The examiner notes; however, that Applicant has not claimed that the digital information provides functionality in isolation. Furthermore, as noted in the Office Action mailed 12/07/2007, Stefik et al. discloses attaching metering rights to a digital work (col. 10, l. 58-64; col. 22, l. 51-56; col. 23, l. 13-26; col. 25, l. 35-38; & col. 26, l. 61-65). The credit server clock is used for metering usage fees (col. 14, l. 40-42). A Begin-charges transaction assigns a charge for metered use. An End-charges transaction ends a charge for metered use. A report-charges transaction between a personal credit server and a billing clearinghouse is invoked at least once per billing period, and is used to pass along information about charges (col. 31, l. 26-40). Stefik et al. also discloses that all billing transactions are given a transaction ID (col. 31, l. 43). The examiner notes that the metering rights do provide functionality to the credit server to autonomously monitor the utilization of contents, because the clock in the credit server would not monitor the time usage of contents if metered usage rights were not set. As such, the examiner maintains that Stefik et al. teaches "embedding digital information to said contents, said digital information itself providing functionality to said user terminal to autonomously monitor, and store, a contents utilizing history at the user terminal, and transmit the stored contents utilizing history along with identification information to said information gathering means at a predetermined timing while said user terminal is connected with said network," as currently claimed.